

REMARKS

Claims 1-16 are pending in this application. By this Amendment, claims 9-10 are amended. No new matter is added.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Pond in the October 26, 2004 personal interview. Applicant's separate record of the substance of the interview was made in the October 29 Summary of Substance of Interview, portions of which are repeated below.

Applicant acknowledges the withdrawal of the prior Final Rejection in favor of a new non-final Rejection.

In the Office Action, claim 10 is rejected under 35 U.S.C. §112, second paragraph. By this Amendment, claim 10 is amended consistent with the Examiner's comments to clarify the intended means plus function language for the last recited element. Claim 10 is now deemed concise and definite. As discussed during the personal interview, this should overcome the rejection. Withdrawal of the rejection is respectfully requested.

In the Office Action, claim 9 is rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

It is asserted that claim 9 is merely an abstract idea and has "no practical application in the technological arts to support the core invention." The Office Action goes on to state that a claim is limited to a practical application when the method produces a "concrete, tangible and useful result."

As discussed during the personal interview, Applicant respectfully submits that claim 9 does in fact claim more than an abstract idea and produces a concrete, tangible and useful result. Although the preamble states the context of an "electronic commercial transaction" during which the specified method steps occur, claim 9 has been revised to clarify that specified steps are performed electronically.

Moreover, as a result of the claim steps, specific concrete, tangible and useful results are obtained. For example, upon entry of specified parts and a user-designated installation date, the method effects identification of at least one concrete candidate facility at which the part can be installed on the user-designated installation date and provides this real, concrete and tangible candidate facility with information relating to a reservation for installation. Thus, this is more than mere manipulation of abstract data, but an electronic commercial transaction in which a user is electronically provided with identification of a facility at which the user can obtain a part and installation of the part in a user-designated time frame. This is a "useful" result because it eliminates the need for a user to manually research whether any facilities have the part and to manually inquire whether any facilities are capable of performing the desired task on the desired user timeline. Such steps result in effecting a specific concrete commercial transaction involving reserving installation of a specified part on a specified date at a facility.

Accordingly, claim 9 meets all statutory requirements for being patentable subject matter. Withdrawal of the rejection is respectfully requested.

It is noted that no new grounds of rejection are made in this latest Office Action. Rather, in the Office Action, claims 1-8 remain rejected under 35 U.S.C. §103 over the Hyundai collection of articles in view of the BW article. Additionally, claims 9-10 remain rejected under 35 U.S.C. §103 over Hyundai and BW article further in view of Official Notice. Finally, claims 11-16 remain rejected under 35 U.S.C. §103 over Hyundai and BW articles and further in view of a PR news wire article. These rejections are respectfully traversed.

As argued in Applicant's prior response and during the personal interview, the invention is directed to methods and apparatus for effecting electronic commercial transactions that allow at least one part to be installed on a user-designated installation date.

Each of the independent claims recite specific methods, means or structure that enables electronic searching for user selected parts and searching for at least one candidate installation facility based on user-designated installation date criteria (and the implicit requirement that the facilities provide appointment date to identify such candidate facilities). This tailored and client driven information is then provided to a user to greatly simplify the transaction.

In the Office Action, it is admitted that Hyundai and BW collectively fail to teach or disclose a user-specified installation date. Thus, even if combined, the Office Action fails to provide a *prima-facie* case of obviousness. Moreover, it is evident from the record that even assuming that the specific unsupported allegations of obviousness were true, which is not admitted, the allegations still fail to address each and every feature of the various independent claims. Furthermore, the Office Action is silent as to any motivation for the alleged combination of references.

As set forth in MPEP §2143.03, a *prima facie* case of obviousness cannot be established where there is no motivation for the combination and, even if combined, all of the claim limitations are not taught or suggested by the prior art. That is, all words, structure and steps in a claim must be considered in judging the patentability of that claim against the prior art. This has not been done with respect to the pending claims.

Each of the various independent claims do not involve an abstract idea of providing a user-designated installation date or mere scheduling of an appointment, but rather provide specific methods and systems in which a user is able to readily identify candidate facilities at which a specific part can be obtained and can be installed on a user-designated installation date.

For example, the various independent claims recite systems and methods that determine from a vast number of unknown facilities, which of such facilities first have the

desired parts, and then which of such subset of facilities also have the ability to install the designated part on a specified user-designated installation date. This requires specific entry of criteria by the user, and availability of facility appointment schedule information for the search engine to perform the search. Such is not taught by the alleged references.

Hyundai only addresses ordering of parts and has no appreciation of installation problems or of scheduling installation. BW only addresses a repair forum, an unrelated capability of ordering new vehicles online, and generally describes (with no detail) the ability to schedule an automotive service appointment online. However, there are many possible ways in which scheduling could be achieved. The Office Action discusses unsupported allegations that the motivation to combine would be to provide convenient online experiences, and that an installation date would be discussed.

However, there is no discussion of selection of a facility in BW. It is plausible that a user merely selects a suitable dealer, or searches for one based on geographic location. The dealer selected may then schedule the appointment in a well-known first-come, first-served manner. Accordingly, with such a plausible scenario, there is only a one-to-one user to facility scheduling that involves no search criteria by user installation date as claimed. Moreover, it is wholly plausible for such scheduling to be on terms and conditions set by the dealer, as is predominant in the art of vehicle repair. Accordingly, there are many possible methods of effecting a transaction other than the specific methodology claimed. Moreover, there is no association between ordering of a part and installation of that part in one convenient consolidated system and method.

Applicant's various claims recite identification of a user-designated installation date as a predetermined criteria entered and the availability of facilities' appointment data as prerequisites for the electronic searching and commercial transaction to occur. Appointment data in the art is commonly located at solely the facility for its internal use, and is not

typically divulged to third parties. Thus, it would be difficult to implement the recited methods without a major change in the way most appointment information is collected and made available. Moreover, in many cases, there is no electronic form of such appointment data, even for internal use. Rather, it is maintained in manual calendar form. Thus, third party access to such data in searchable form is not typical in the art. Instead, only after a potential client identifies and contacts a particular facility, is it known the possible availability of the facility. Even then, it may be the case that an appointment is scheduled through one-to-one communication with the facility, without the client even knowing the availability of the facility to perform a specific task or the facility knowing it has a part available. Rather, as indicated above, it is more often the case that the vehicle is dropped off for service and will be completed at the time schedule of the facility, such as in a first come, first serve order. Moreover, conventional systems do not identify all candidate facilities capable of meeting the customer's timing and part needs. These problems are addressed by aspects of the invention and provide a more user-friendly transaction experience to the customer, allowing the ability to choose a qualified candidate facility from among these based on other considerations, such as for example convenience, reputation, etc.

Only with impermissible hindsight consideration of Applicants' specification is the specific solution to such a problem identified. The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the specific combination claimed (MPEP §2143.01).

The applied art, even in combination, fails to teach a method or system in which a part can be ordered and a user-designated installation data used as search criteria to locate available candidate facilities that can install the ordered part on the user-designated date, and providing this facility information to the customer for selection of a user designated facility from the candidate facilities capable of delivering on the user's terms.

Because the Office Action fails to provide sufficient motivation for the combination of Hyundai and BW and because, even if combined, there is no teaching of the specific recited structure and methods, the Patent Office has failed to meet its burden in establishing a *prima facie* case of obviousness. Withdrawal of the rejections and prompt allowance of the pending claims are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-16 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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